

Notice of Allowability

Application No.

10/511,554

Examiner

Chukwuma O. Nwaonicha

Applicant(s)

WELZ-BIERMANN ET AL.

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/20/06.
2. ☒ The allowed claim(s) is/are 1-8, 10 and 11 (now renumbered 1-10, respectively).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 20 November 2006.
2. Claims 1-8 and 10-14 are pending in the application.

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 11/20/06 is acknowledged. Applicants' traversal of restriction requirement is not persuasive because the inventions listed as Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group 1 is drawn to a process for the preparation of perfluoroalkylphosphines while Group 2 is drawn to perfluoroalkylation of chemical substrates. These are two different chemical processes and require different search strategies that will impose an undue burden on the Examiner. Therefore there is no special technical feature for the compounds, the processes of making these compounds or the different fields of application of the compounds. Also there is no unity of invention.

The requirement is still deemed proper and is therefore made **FINAL**.

Group 2 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. All claims consisting of Group 1 will be examined on the merits. Applicants are reminded of their right to file divisional applications to the non-elected claims.

Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Harry Shubin on 12/6/06.

The Application has been amended as follows:

Claims 12-14 have been cancelled.

Allowed Claims

Claims 1-8, 10 and 11 are allowable over the prior art of record.

Reason For Allowance

The following is an examiner's statement of reasons for allowance: Applicants claim a process for the preparation of perfluoroalkylphosphines, comprising reacting at least one fluoro(perfluoroalkyl)phosphorane with at least one hydride ion donor under reflux, wherein all the variables are as defined in the claims. The process was neither found to be obvious nor anticipated by the prior art of record.

The closest prior art is Gilje et al., {Preparation and nuclear magnetic resonance parameters of perfluoroalkyl-substituted phosphorus(V) hydrides, Journal of the Chemical Society, Chemical Communications, 1973, 813 - 814}. Gilje et al. teach a process for the preparation of perfluoroalkylphosphines by reacting $(\text{CF}_3)_2\text{PF}_2$ and Me_2SiH .

Applicant process for the preparation of perfluoroalkylphosphines differs from Gilje et al. process in that Gilje et al. process is in vapor phase while applicants claim a process wherein the reaction is conducted under reflux. Another difference between applicants claimed process and Gilje et al. is that Gilje et al. do not isolate their product while applicants claimed a process wherein the product is isolated. These differences are not readily apparent and would not have been suggested to one of ordinary skill.

All claims (1-8, 10 and 11) are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

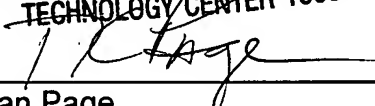
Art Unit: 1621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.
Patent Examiner
Art Unit: 1621

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600


Thurman Page,
Supervisory Patent Examiner,
Technology Center 1600